

REMARKS/ARGUMENTS

In the Office Action mailed February 15, 2008, claims 8-13 were rejected. In response, Applicants hereby request reconsideration of the application in view of the proposed amendments and the below-provided remarks. No claims are added. Applicants submit that the proposed amendments place the present application in condition for allowance or in better condition for appeal.

For reference, claims 8, 10, 11, and 13 are amended. In particular, claim 8 is amended to include limitations related to the limitations previously recited in claim 9. Consequently, claim 9 is canceled, and claim 10 is amended to depend from claim 8. Each of claims 11 and 13 are amended to reformat the claims in independent format, as suggested by the Examiner.

Withdrawal of Finality

As a preliminary matter, Applicants respectfully submit that the finality of the present Office Action is premature because the present Office Action does not establish *prima facie* rejections for all of the claims. In particular, the Office Action does not establish *prima facie* rejections at least for claims 10, 11, and 12, as explained below. While the present Office Action attempts to generally address some of the limitations of independent claim 8, the Office Action does not address the specific limitations of claims 10, 11, and 12. Additionally, the reformatting of claim 11, for example, in independent format in the present response does not negate the Examiner's responsibility to address all of the limitations which were previously recited in claim 11 through incorporation of the limitations of claims 8 and 10, from which claim 11 previously depended. Therefore, given that the present Office Action does not address all of the limitations of claims 10, 11, and 12, as explained below, Applicants submit that the finality of the present Office Action is premature. Accordingly, Applicants respectfully request that the finality of the present Office Action be withdrawn.

Objections to the Claims

The Office Action objected to claims 11-13 because of informalities. In particular, the Office Action suggests claims 11 and 13 should be rewritten in independent format to clearly show the limitations of the claims. Applicants submit that claims 11 and 13 are rewritten in independent format, as suggested by the Examiner. Accordingly, Applicants respectfully request that the objections to claims 11-13 be withdrawn.

Claim Rejections under 35 U.S.C. 103

Claims 8-13 were rejected under 35 U.S.C. 103(a) as being unpatentable over Tamura at al. (JAP Pat. Pub. No. JP2001092934, hereinafter Tamura) in view of Pickett et al. (U.S. Pat. No. 5,451,763, hereinafter Pickett). However, Applicants respectfully submit that these claims are patentable over Tamura and Pickett for the reasons provided below.

Independent Claim 8

Claim 8, as amended, recites “wherein in the closed position the first and second plate of the capacitive element are substantially aligned to disable access by the base station” (emphasis added).

The Office Action recognizes that Tamura does not teach a coupling element defined as a capacitive element in the form of a capacitive plate. Hence, the Office Action relies on Pickett as teaching a coupling element designed as a capacitive element in the form of a capacitive plate. Nevertheless, Applicants maintain that the combination of Tamura and Pickett is improper because the type of data transfer purportedly enabled by Pickett using sets of capacitive plates is not suitable for the conditions described in Tamura, and Tamura specifically teaches away from the type of system implemented in Pickett. Additionally, even if the combination of Tamura and Pickett were proper, Applicants assert the combination of Tamura and Pickett does not teach all of the limitations of the claim because the combination of Tamura and Pickett does not teach disabling access when first and second plates of the capacitive element are in a closed position.

- I. The combination of Tamura and Pickett is not proper because the type of data transfer used and Pickett is not suitable for the conditions described in Tamura and Tamura teaches away from the proposed combination.

In general, the capacitive plates of Pickett are designed for use with corresponding capacitive plates on a read/write unit which requires the capacitive plates of the IC card to be placed in close proximity to the corresponding capacitive plates of the read/write unit. In fact, the IC card does not appear to be capable of contactless transmission because the IC card is inserted into the read/write unit in order to transfer data between the read/write unit and the IC card. Pickett, col. 4, lines 4-16. Thus, even though the various capacitive plates of Pickett may not be electrically connected, the operating environment described in Pickett nevertheless appears to require that the IC card is in contact with the read/write unit in order to perform the data transfer. In other words, the data transfer between the IC card in the read/write unit is not contactless at least because the IC card is in contact with the read/write unit.

In contrast, Tamura generally describes contactless transmission using a booklet object which is carried by a person and outputs electronic information while the person carries a booklet object. Tamura, claim 18. In fact, Tamura specifically teaches away from using a “contact smart card” which operates through insertion of an IC card in an IC card reading/write-in machine (referred simply as an IC card R/W) because these types of systems tend to receive mechanical damage by insertion of the IC card into the IC card R/W and extraction of the IC card from the IC card R/W. Tamura, paragraph 8. Thus, since the system described in Pickett uses an IC card and an external Read/Write unit, the system described in Pickett is a “contact smart card” system which Tamura explicitly teaches away from using.

Therefore, the proposed combination of Tamura and Pickett is improper at least because Tamura specifically teaches away from the type of “contact smart card” system implemented in Pickett. Accordingly, Applicants respectfully request that the rejection of claim 8 be withdrawn because the combination of Tamura and Pickett is improper.

II. The combination of Tamura and Pickett does not teach disabling access when first and second plates of the capacitive element are in a closed position.

Moreover, even if the teachings of Pickett were combined with Tamura, the combination of Tamura and Pickett nevertheless fails to teach all of the limitations of the claim because the combination of Tamura and Pickett does not teach disabling access when first and second plates of the capacitive element are in a closed position, as recited in claim. While Tamura purportedly teaches disabling access to a booklet object which uses a coil-like antenna, and Pickett apparently teaches capacitive plates generally, the proposed combination of Tamura and Pickett does not provide any explanation of how the capacitive plates of Pickett might be used to disable access to the booklet object of Tamura. Although Tamura teaches how to prevent an induced current in a coil-like antenna, neither Tamura nor Pickett nor the proposed combination provides any teaching about how to prevent an induced current using one or more capacitive plates instead of the coil-like antenna of Tamura.

Moreover, while the present application claims using capacitive plates to disable access when the capacitive plates are in a closed position, the teachings of the present application cannot be used to provide the details of operation for the proposed combination. In fact, reliance on the teachings of the present application to show how the proposed combination of capacitive plates from Pickett with the booklet object of Tamura would require impermissible hindsight because the present Office Action fails to provide any other evidence or explanation regarding how the capacitive plates of Pickett might be used in the booklet object of Tamura to disable access to the booklet object when the capacitive plates are in a closed position.

Therefore, the combination of Tamura and Pickett does not teach all of the limitations of the claim because the combination of Tamura and Pickett does not teach how to disable access when capacitive plates are in a closed position. Accordingly, Applicants respectfully submit claim 8 is further patentable over the combination of Tamura and Pickett because the combination of Tamura and Pickett does not teach all of the limitations of claim.

Independent Claim 11

Applicants respectfully assert independent claim 11 is patentable over the combination of Tamura and Pickett at least for similar reasons to those stated above in regard to the rejection of independent claim 8. In particular, claim 11 recites “wherein in the closed position the first and second plate of the capacitive element are substantially aligned to disable access by the base station” (emphasis added).

Here, although the language of claim 11 differs from the language of claim 8, and the scope of claim 11 should be interpreted independently of claim 8, Applicants respectfully assert that the remarks provided above in regard to the rejection of claim 8 also apply to the rejection of claim 11. Accordingly, Applicants respectfully assert claim 11 is patentable over the combination of Tamura and Pickett because the combination of Tamura and Pickett is improper. Claim 11 is further patentable over the combination of Tamura and Pickett because the combination of Tamura and Pickett does not teach all of the limitations of claim.

Additionally, as a separate basis for patentability, Applicants submit that the rejection of claim 11 is improper because the Office Action does not establish a *prima facie* rejection for claim 11. In order to establish a *prima facie* rejection of a claim under 35 U.S.C. 103, the Office Action must present a clear articulation of the reason why the claimed invention would have been obvious. MPEP 2142 (citing *KSR International Co. v. Teleflex Inc.*, 550 U.S. ____ (2007)). Here, the Office Action fails to explain why the limitations of claim 11 would have been obvious because the Office Action does not acknowledge the actual language of claim 11. In particular, the Office Action fails to acknowledge that claim 11 recites “the first plate of the capacitive element comprising individual part-areas connected to one another” (emphasis added) and “the second plate of the capacitive element comprising additional individual part-areas connected to one another” (emphasis added). In fact, the Office Action does not even make an assertion that the cited references might describe the indicated limitations, or that the indicated limitations might otherwise be obvious in light of the cited references. While the Office Action assert some general and conclusory comments about data protocols and access codes, the Office Action nevertheless fails to address the limitations regarding individual part-areas of the first and second plates, as recited in claim. Therefore, the Office Action

fails to establish a *prima facie* rejection for claim 11 at least because the Office Action does not assert or show how the cited references might teach individual part-areas according to the limitations of the claim. Accordingly, Applicants respectfully submit that the rejection of claim 11 under 35 U.S.C. 103(a) should be withdrawn because the Office Action fails to establish a *prima facie* rejection.

Independent Claim 13

Applicants respectfully assert independent claim 13 is patentable over the combination of Tamura and Pickett at least for similar reasons to those stated above in regard to the rejection of independent claim 8. In particular, claim 13 recites “wherein in the closed position the first and second plate of the capacitive element are substantially aligned to disable access by the base station” (emphasis added).

Here, although the language of claim 13 differs from the language of claim 8 and the scope of claim 13 should be interpreted independently of claim 8, Applicants respectfully assert that the remarks provided above in regard to the rejection of claim 8 also apply to the rejection of claim 13. Accordingly, Applicants respectfully assert claim 13 is patentable over the combination of Tamura and Pickett because the combination of Tamura and Pickett is improper. Claim 13 is further patentable over the combination of Tamura and Pickett because the combination of Tamura and Pickett does not teach all of the limitations of claim.

Dependent Claims

Claims 10 and 12 depend from and incorporate all of the limitations of the corresponding independent claims 8 and 11. Applicants respectfully assert claims 10 and 12 are allowable based on allowable base claims. Additionally, claims 10 and 12 are allowable for further reasons, as described below.

In regard to claim 10, Applicants respectfully submit that claim 10 is patentable over the combination of Tamura and Pickett because the Office Action fails to establish a *prima facie* rejection for claim 10. In particular, claim 10 recites limitations similar to the limitations recited in claim 11, which are not addressed in the Office Action, as explained above in regard to the rejection of claim 11. Therefore, the Office Action fails

to establish a *prima facie* rejection for claim 10 at least because the Office Action does not assert or show how the cited reference might teach individual part-areas according to the limitations of the claim. Accordingly, Applicants respectfully submit that the rejection of claim 10 under 35 U.S.C. 103(a) should be withdrawn because the Office Action fails to establish a *prima facie* rejection.

In regard to claim 12, Applicants respectfully submit that claim 12 is also patentable over the combination of Tamura and Pickett because the Office Action does not establish a *prima facie* rejection for claim 12. As explained above, in order to establish a *prima facie* rejection of a claim under 35 U.S.C. 103, the Office Action must present a clear articulation of the reason why the claimed invention would have been obvious. MPEP 2142 (citing *KSR International Co. v. Teleflex Inc.*, 550 U.S. ____ (2007)). Here, the Office Action fails to explain why the limitations of claim 12 would have been obvious because the Office Action does not acknowledge the actual language of claim 12. In particular, the Office Action fails to acknowledge that claim 12 recites “wherein the read/write station is informed of the coding through information contained in the electronic data carrier to enable the contactless transmission only in an event of identical selection at the electrode connections of the individual part-areas” (emphasis added). Since the Office Action does not address the individual part-areas, as described above, the Office Action also fails to address the limitation of claim 12 related to enabling the contactless transmission only in an event of identical selection at the electrode connections of the individual part-areas. Therefore, the Office Action fails to establish a *prima facie* rejection for claim 12 at least because the Office Action does not assert or show how the cited reference might teach individual part-areas or enabling the contactless transmission according to the limitations of the claim. Accordingly, Applicants respectfully submit that the rejection of claim 12 under 35 U.S.C. 103(a) should be withdrawn because the Office Action fails to establish a *prima facie* rejection.

CONCLUSION

Applicants respectfully request reconsideration of the claims in view of the proposed amendments and remarks made herein. A notice of allowance is earnestly solicited.

At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account **50-3444** pursuant to 37 C.F.R. 1.25. Additionally, please charge any fees to Deposit Account **50-3444** under 37 C.F.R. 1.16, 1.17, 1.19, 1.20 and 1.21.

Respectfully submitted,

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